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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,046	04/13/2001	Stephen B. Corn	SCW-003	5940
959	7590	12/30/2004	EXAMINER	
LAHIVE & COCKFIELD, LLP. 28 STATE STREET BOSTON, MA 02109			SAADAT, CAMERON	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/835,046

**Applicant(s)**

CORN ET AL.

**Examiner**

Cameron Saadat

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-14 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-14, and 16-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

In response to amendment filed 10/5/2004, claims 1, 3-14, and 16-20 are pending in this application. Claims 2 and 15 are cancelled.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 20 is rejected under 35 U.S.C. 101. The analysis of whether an invention is non-statutory is a two-prong test. First, the claimed invention must be within the technological arts. Mere ideas in the abstract that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. Second, the claimed invention must produce a useful, concrete, and tangible result. *See, State Street Bank and Trust Co. v. Signature Financial Group Inc.*, 149 F.3d at 1373, 47 USPQ2d at 1601-02 (Fed. Cir. 1998). A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. *See In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed Cir. 1994). In this case, claim 20 includes a medium for holding computer-executable steps. The computer-executable steps are merely a set of instructions that are considered nonstatutory descriptive material since there is no computer-readable medium to realize the functionality of the computer-executable steps. Thus, there is no concrete, tangible result.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1, 3-14, 16-17, and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon et al. (USPN 6,678,824; hereinafter Cannon) in view of Lotvin et al. (U.S. Patent No. 5,907,831; hereinafter Lotvin).**

Regarding claims 1, 7, 14, and 20, Cannon discloses a method comprising the steps of: sending a request from a user for a page having educational content; receiving said page; displaying the content to a user; tracking and recording the time the user views the educational content to ensure said user views said content for a time greater than or equal to a minimum time period and less than or equal to a maximum time period; said user receiving continuing education credit from a professional accrediting authority (Col. 2, lines 41-47) for viewing the educational content where said time is between said maximum and said minimum time periods; said viewing of educational content by the user not including an examination based on said content (Col. 4, lines 38-42; Col. 5, lines 34-38). Cannon does not specifically disclose that the request for educational content is sent over a network. However, it is notoriously well known to distribute educational content over a network. Furthermore, Lotvin discloses an educational system wherein a user may request educational content over a network (Col. 18, lines 56-59). Thus, in view of Lotvin, it would have been obvious to modify the educational method described in Cannon by providing the educational content over a network in order to overcome geographical limitations.

Cannon discloses an educational system that provides users with credit for completing or viewing educational content. The educational system is operated and maintained by a parent or guardian (Col. 2,

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lines 41-47). Although not explicitly stated, it is implied that the parents are engaged in the educational system as a professional accrediting authority. In addition, Lotvin teaches an educational system for granting continuing education credit, wherein the educational credit is conferred by an authorized third party and central computer system instead of a parent, in order to provide verification of awarded credits (Col. 19, lines 45-50; Col. 13, lines 1-36). Hence, in view of Lotvin, it would be obvious to an artisan to modify the method of awarding credit, as described in Cannon, by conferring continuing educational credit by a professional accrediting authority, instead of a parent, in order to provide verification of awarded credits.

Regarding claim 3, Cannon discloses a method wherein educational content is presented to a user, but does not explicitly disclose that the educational content is presented in the form of a daily interrogatory and related answer. However, it is the examiner's position that providing educational content in the form of interrogatory and related answer is well known method in the art for conveying educational material to a learner. Hence, it would have been an obvious to one of ordinary skill in the art to modify the educational content described in Cannon, by presenting educational content in the form of daily interrogatory and related answer, in order to effectively convey educational materials to a learner.

Regarding claim 4, Cannon discloses a method comprising the additional steps of: recording the amount of credit granted to each user; and providing the amount of credit granted to each user to said user upon request (See Fig. 2).

Regarding claim 5, Cannon discloses a method wherein said method does not award educational credit to a user of said electronic device for reviewing said educational content as a result of the recorded amount of time exceeding a maximum time parameter (Col. 7, lines 20-24).

Regarding claim 6, Cannon discloses a method comprising the additional steps of: sending a message to the user indicating an inadequate amount of time has been spent reviewing said educational

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content, said message generated as a result of the recorded amount of time not exceeding a minimum time parameter; receiving subsequently from said user a new recorded amount of time; and awarding educational credit to the user based on said new recorded amount of time (Col. 4, lines 38-42; See Fig. 2, virus check)

Regarding claim 7, Cannon discloses a method comprising the steps of: providing a page having educational content over the network; receiving a request for said page from a user; sending said page to the user; tracking and recording the time the user views the educational content to ensure said user views said content for a time greater than or equal to a minimum time period and less than or equal to a maximum time period; and conferring educational credit from a professional accrediting authority on said user in response to said user viewing said educational content for a time greater than or equal to said minimum time period and a time less than or equal to said maximum period, said viewing of said educational content not including an examination of said user based on content (Col. 4, lines 38-42; Col. 5, lines 34-38).

Regarding claims 8-13, Cannon discloses all of the claimed subject matter with the exception of explicitly disclosing specific limitations of advertising units. However, Lotvin discloses an educational method, comprising the steps of (as per claim 8) providing a page having one or more educational units and one or more advertising units; associating one or more of said advertising units with one or more of said educational units such that said advertising unit is displayed in connection with said educational unit (column 8, lines 5-12); (as per claim 9) wherein a plurality of said advertising units constitutes an advertisement (column 8, line 10); (as per claim 10) wherein said advertising units are indexed to said educational units (column 8, lines 5-12); (as per claim 11) wherein said advertising units displayed are specific to the user (column 6, line 64 – column 7, line 5); (as per claim 12) wherein said advertisement is part of a sequence of advertising, said sequence of advertising being synchronized with the sequence of educational units (column 8, lines 10-12); and (as per claim 13) forwarding said educational unit and an

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associated advertisement to a user-designated recipient (column 8, lines 10-12). Hence, in view of Lotvin, it would have been obvious to one of ordinary skill in the art to modify the educational units described in Cannon, by providing advertising units within the educational units in order to promote educational products to a targeted audience comprising people that are interested in educational products.

Regarding claim 14, Cannon discloses a method comprising the steps of: providing a plurality of pages holding educational content, said educational content grouped by topics (see fig 2), said topics divided into a plurality of educational units providing substantially complete content, said educational units stored on said pages; receiving a request from a user of an electronic device interfaced with said network for one of said pages; forwarding said page in response to said request; receiving an indication from said user that said user has completed reviewing said educational content, said review lasting equal to or longer than a minimum time parameter and less than or equal to a maximum time parameter and not including an examination based on said content; and conferring education credit on said user from a professional accrediting authority (Col. 4, lines 38-42; Col. 5, lines 34-38).

Regarding claim 16, Cannon discloses a method comprising the additional steps of: grouping selected educational units so as to form a course; registering said user for said course; and sending said educational units forming said course to said electronic device for review by said user (See Figs. 2, 4).

Regarding claim 17, Cannon discloses all of the claimed subject matter with the exception of explicitly disclosing the steps of providing user response to the author of said educational units after said user reviews said educational units; and altering other educational units based on said user response. However, Lotvin discloses a method comprising the additional steps of: providing user response to the author of said educational units after said user reviews said educational units; and altering other educational units based on said user response (column 8, lines 25-27; column 5, lines 29-38). Hence, in view of Lotvin, it would have been obvious to an artisan to modify the educational method described in

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Cannon, by allowing a user to respond to an author and altering the educational units based on user responses, in order to deal with problems and concerns of users with the educational system.

Regarding claim 19, Cannon discloses all of the claimed subject matter with the exception of explicitly disclosing the step of providing a search feature for the educational unit for searching multiple educational units. However, Lotvin discloses a method comprising the additional step of: providing a search feature for said educational unit, said search feature searching multiple educational units on a plurality of web pages utilizing a single query (column 6, lines 30-33). Hence, in view of Lotvin, it would have been obvious to an artisan to modify the educational method described in Cannon, by providing a search feature for identifying and retrieving educational content from a database for presentation to a user.

**Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cannon et al. (USPN 6,678,824; hereinafter Cannon) in view of Lotvin et al. (U.S. Patent No. 5,907,831; hereinafter Lotvin), further in view of Sonnenfeld (USPN 6,112,049).**

Regarding claim 18, Cannon discloses all of the claimed subject matter with the exception of explicitly disclosing that the educational content comprises a crossword puzzle. However, Lotvin discloses a method comprising the additional steps of: presenting educational content to a user in the format of a crossword puzzle (column 11, lines 41-44); and using said crossword puzzle completion as a basis for awarding continuing education units to said user (column 6, lines 11-13). Neither Cannon nor Lotvin explicitly disclose hyperlinks provided to the correct answers for the crossword puzzle. However, Sonnenfeld teaches a method wherein hyperlinks of correct answers of educational units are provided (column 9, lines 43-44). Thus, it would have been obvious to a person of ordinary skill in the art to modify the educational unit described in the combination of Cannon and Lotvin, by providing hyperlinks to correct answers, in light of the teachings of Sonnenfeld, thereby providing the user with feedback on his/her performance on the educational unit.



*Response to Arguments*

Applicant's arguments with respect to claims 1, 3-14, and 16-20 have been considered but are not persuasive. Applicant asserts that Cannon discusses the conferral of a credit that is not a continuing education credit, but rather a credit that a user may redeem to play a non-beneficial program/game. The examiner respectfully disagrees.

Claims are given their broadest reasonable interpretation in light of the supporting disclosure. In *re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. In *re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed. An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.

According to the American Heritage® Dictionary, *continuing education* is an instructional program that brings participants up to date in a particular area of knowledge or skills. Thus, Cannon provides continuing education credit when a user views educational content for a predetermined period of time set forth by a parent or guardian. The fact that Cannon's continuing education credit allows a user to redeem game play does not dismiss Cannon's teaching of granting continuing education credit for viewing the educational content for a predetermined time.

Applicant additionally emphasizes that neither Cannon nor Lotvin teach or suggest the conferral of continuing education credit *by a professional accrediting authority*. However, Cannon discloses an educational system that provides users with credit for completing or viewing educational content. The

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educational system is operated and maintained by a parent or guardian (Col. 2, lines 41-47). In this case, the parents are engaged in the educational system as a professional accrediting authority. In addition, Lotvin teaches an educational system for granting continuing education credit, wherein the educational credit is conferred by an authorized third party and central computer system instead of a parent, in order to provide verification of awarded credits (Col. 19, lines 45-50; Col. 13, lines 1-36). Thus, in view of Lotvin, it would have been obvious to modify the educational method described in Cannon by providing the educational content over a network in order to overcome geographical limitations.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cameron Saadat whose telephone number is (571) 272-4443. The examiner can normally be reached on M-F 9:00 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CS



XUAN M. THAI  
PRIMARY EXAMINER

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